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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/799,528

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David J. Paul

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LAW OFFICE OF ALAN W. CANNON
942 MESA OAK COURT
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EXAMINER

MAI, HAO D

ART UNIT

PAPER NUMBER

3732

MAIL DATE

DELIVERY MODE

06/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/799,528	Applicant(s) PAUL ET AL.	
	Examiner HAO D. MAI	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 128-137 and 145-150 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 128-137 and 145-150 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of claims 131, 135-137, 145-147, and 149, is withdrawn in view of new ground(s) of rejections as follows:

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 131, 145, and 149**, rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite the limitation "the shape of a cowboy hat", which renders indefiniteness because:

- 1) There are indefinitely different shapes for a cowboy hat;
- 2) There is not one definite shape of a cowboy hat; and if there is a general conventional shape for a cowboy hat, such conventional shape may be changed by fashion trend; and
- 3) It is unclear which part of a cowboy hat the claim language is referring to.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3732

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 128-129, and 147-148, are rejected under 35 U.S.C. 102(b) as being anticipated by Taylor et al. (6036641).

Regarding claims 128 and 148, Taylor et al. discloses a device 1 (Fig. 8) capable of providing additional stabilization to tissue already in contact with a primary stabilization member, the device comprising: a single, substantially rigid tissue contact member 1 formed as a unitary continuous loop capable of being placed on the tissue; and a connecting member/handle 3 integrally formed with and extending from the tissue contact member and capable of being hand held or fixed to a relatively immovable object. The contact member 1 is shown to incline upwardly at: (1) an outer perimeter portion shown at reference 43, and (2) an outer perimeter 41 (Fig. 8).

As to claim 147, all the elements are shown with respect to claims 128 and 148. Note that Figure 8 also shows the canting upwardly from a lower surface 42 located interiorly of outer perimeter 41; the device is capable of having the lower surface 42 contacting the tissue while the outer perimeter portion 41 contacts the primary stabilization member.

As to claims 129, tissue contact member 1 is shown to comprise a base 42 having a central opening therethrough, said central opening is capable of allowing access to a target site on the tissue.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made

Art Unit: 3732

to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 130-131, 145, and 149, are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al. (6036641).

Taylor et al. disclose the invention substantially including the base member 42 canting upwardly around an outer perimeter thereof. However, Taylor et al. fail to disclose the base member of the tissue contact member being substantially oval-shaped and canting upwardly around an outer perimeter in the shape of a cowboy hat.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Taylor et al. by making the base member of a substantially oval-shape and canting upwardly at an outer perimeter in the shape of a cowboy hat. Such modification is merely a design choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration or shape of the tissue contacting member was significant. MPEP § 2144.04.

8. Claim 132-137, 146, and 150, are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al. (6036641) in view of Borst et al. (5836311).

Taylor et al. disclose the invention substantially as claimed. As to claims 132-134, however, Taylor et al. fail to disclose the base member having a substantially hollow interior being fluidly connected with the handle and having fluidly connected openings through a bottom surface.

Borst et al. disclose a base member 81 having substantially hollow interior and integral suction ports/openings 82 at the bottom surface thereof; the hollow interior and the suction ports/openings 82 are capable of developing and applying a negative pressure to the tissue (Fig. 13; column 7 lines 18-41). Figure 13 also shows a connecting member/handle being fluidly

Art Unit: 3732

connected to the hollow interior of base 81 and is capable of being connected to a source of negative pressure (column 7 lines 18-35). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Taylor et al. by including the hollow interior with suction ports/openings at the bottom surface, being fluidly connected to the handle which is being connected to a source of negative pressure/suction in order to provide a suction mechanism that suck onto or seal with the tissues, providing a more effective stabilization of the heart.

As to claims 135-137, in an alternative embodiment of Figure 9, Taylor et al. disclose in the base member having openings 147 through an upper surface thereof; the openings being fluidly connected with a lumen 48 that is connectable with a source of pressure; the lumen 148 is shown to run inside the connecting member/handle (column 17 lines 30-42); and in the embodiment of Figure 9C, a manifold is shown to mount inside the base member and fluidly connected the lumen with the openings (column 17 lines 51-55). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate to Taylor's embodiment of Figure 8 in combination with Borst' the openings through the upper surface and the lumen providing pressure independent from that of Borst' hollow interior's negative pressure so that the openings through the upper surface having an independent source of pressure (either negative/suction or positive/blowing) can provide a clear and dry surgical site as taught by Taylor et al.

Regarding claims 146 and 150, Taylor and Borst in combination disclose the invention with all the claimed elements as detailed above with respect to claims 128-137.

Art Unit: 3732

Response to Arguments

9. Applicant's arguments filed 01/14/2008 have been fully considered but they are moot in view of new ground(s) of rejection.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAO D. MAI whose telephone number is (571)270-3002. The examiner can normally be reached on Monday-Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hao D Mai/
Examiner, Art Unit 3732

/Cris L. Rodriguez/
Supervisory Patent Examiner, Art Unit 3732